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EXAMINER

COLIN, CARL G

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/558,192	Applicant(s) NARASIMHASWAMY ET AL.	
	Examiner CARL COLIN	Art Unit 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 12/17/2008, Applicant amends claims 1, 12, 16, 20, 27, and 33. The following claims 1-33, 37-41 are presented for examination.

1.1 Applicant's arguments filed on 12/17/2008 have been fully considered but they are not persuasive. With regard to claim 1, Applicant argues that the prior art does not disclose the claim limitations i.e. "requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket information number for the permanently locked disclosure" as amended. However, these features are Applicant's Admitted Prior Art and they are disclosed on page 2, lines 21-28 of the original specification as filed. Assigning a docket identification number to an invention disclosure has been a common practice well-known in the art and as disclosed in applicant's IDS US 2006/0224412 by Frank et al. Takano also discloses assigning a reference number or serial number to the invention disclosure. Upon further consideration, Applicant has not overcome the rejection of the claims as amended and a new ground of rejection is set forth below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.1 Claims 1-33 and 37-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 12, 16, 20, 27, and 33 recite “***requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket information number for the permanently locked disclosure***”. However, the original specification as filed does not provide enough support for the claims as amended. After careful review and search, Examiner only found page 11 lines 5-12 with figure 2 disclosing “*the accept disclosure transmission block 56 locks the document so no further changes can be made and obtains a docket ID number from a docketing system 58. The disclosure system makes the request and the docket system provides the next available docket number*”. The request mentioned here is a request for docket ID as explicitly illustrated in fig. 2 “requesting docket ID”, not a request of a next available docket information number for the permanently locked disclosure as claimed. Therefore, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of US Patent 5,031,214 to **Dziewit et al** (*Applicant's IDS*), in view of AAPA (Applicant's Admitted Prior Art), and in view of US Patent 6,434,580 to **Takano**.

As per claim 1, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of selected information including a first inventor (user/approver) identification information from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 15-16); *as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); *prompting approval of said first inventor (user/approver)* (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); and **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure after approval, by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a

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permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *after approval permanently locking the disclosure to prevent further editing of the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers

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in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure*. However, these features are either implicit, inherent, or obvious in the system disclosed by **Takano** between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

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“Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked.”

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 2, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 3, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see **Lemble**, column 10, lines 44-52).

As per claim 4, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 5, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein forming is performed by a non-inventor author (see **Lemble**, column 5, lines 15-20 and column 14, lines 40-60).

As per claim 6, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein the step of forming comprises identifying a second inventor; and further comprising the steps of notifying the second inventor; and, prompting the second inventor to approve the invention disclosure (see **Lemble**, column 18, lines 1-22; abstract, and figure 4).

As per claim 7, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising revising the disclosure by the second inventor to form a revised disclosure, and prompting the first inventor to approve the revised disclosure (see **Lemble**, column 20, line 40 through column 21, line 54).

As per claim 8, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein prompting the second inventor comprises providing an E-mail to the second inventor (see **Lemble**, column 18, lines 1-22).

As per claim 9, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein prompting comprises the step of prompting the approval of an associated document (see **Lemble**, column 5, lines 21-25; column 9, lines 53-56; figures 4 and 6; and abstract).

As per claim 10, the combination of **Lemble, Dziewit et al**, and **Takano** discloses wherein the associated document is selected from a group consisting of an assignment document, and a power of attorney. **Takano** teaches preparing an online patent application which implicitly or inherently includes assignment document and power of attorney (see **Takano**, column 19, lines 14-53). Therefore, claim 10 is rejected on the same rationale as the rejection of claim 1 above.

As per claim 11, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising allowing access to various users for obtaining the information (see **Lemble**, column 5, lines 15-32 and abstract).

As per claim 20, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of selected information including a first inventor (user/approver) identification information and a second inventor (approver) identification information from a user computer* (see column 6, lines 9-15; lines 35-36; column 10, lines 43-52; column 19, lines 50-55; column 20, lines 40-65; and abstract; and figures 15-16); *as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location* (see column 5, lines 44-48; and figs. 2-3 with description); *prompting approval of said first inventor* (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); *notifying the second inventor (approver) and, prompting the second inventor to approve the invention disclosure* (see **Lemble**, column 18, lines 1-22; abstract, and figure 4). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure to create a locked disclosure when the second inventor approves the disclosure (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital

signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the second inventor approves the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art

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teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10).

Takano further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.*

However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art (AAPA) discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 21, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 22, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see **Lemble**, column 10, lines 44-52).

As per claim 23, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**,

column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 24, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising locking the disclosure when the second inventor approves the disclosure (see **Lemble**, column 5, lines 33-40). (As shown in fig. 4 first or second approver (second inventor) can be the last approver).

As per claim 25, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising locking the disclosure when the first inventor approves the revised disclosure (see **Lemble**, column 20; column 6, lines 9-23; and column 5, lines 33-40). **Lemble** discloses a revised disclosure can be sent to a first user or first approver for approval if the user or first approver is the last approver locking the disclosure may take place.

As per claim 26, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of wherein providing an E-mail to the second inventor comprises providing an E-mail to the second inventor having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

As per claim 27, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of information including one or more inventor identifications from one or more inventors to form an invention*

disclosure from a user computer (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 15-16); *storing the information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); *prompting approval of the one or more inventors* (user/approver) (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure to create a locked disclosure after each of the one or more inventors approve the disclosure, by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure after each of the one or more inventors approve the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of

a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the

patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.*

However, these features are either implicit, inherent, or obvious in the system disclosed by **Takano** between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10), and requesting a docket number and

obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 28, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 29, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval from each of the one or more inventors (see **Lemble**, column 10, lines 44-52).

As per claim 30, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 31, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein prompting comprises prompting the one or more inventor comprises providing an E-mail to the one or more inventors having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

As per claim 32, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of wherein providing an E-mail to the one or more inventors comprises providing an E-mail to the one or more inventors having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

4. **Claims 16-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of US Patent 5,031,214 to **Dziewit et al** (*Applicant's IDS*) in view of AAPA (Applicant's Admitted Prior Art), and in view of US Patent 6,434,580 to **Takano**.

As per claim 16, **Lemble** discloses an invention disclosure system comprising *a user computer, a server*, (see figure 1 and tables in column 7 and column 9); *a database coupled to the server* (see figure 1 and figure 3 and column 4, line 39). **Lemble** further discloses *said server providing user screens to said users to prompt users to provide disclosure information to said server*, (see figure 2 and claims 5-6); *receiving disclosure information from said users, including a first inventor identification and a second inventor identification* (see column 6, lines 9-15; column 19, lines 50-55; column 20, lines 40-65; and abstract); storing information in said database (see column 3, lines 40-62 and column 4, lines 25-47; column 29, lines 8-15; and figure 4); *prompting the first inventor and the second inventor to provide an approval* (see column 5, lines 20-40). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure after the approval by the first inventor and the second inventor (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a

finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking of the document. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *locking the disclosure to prevent further editing after the approval by the first inventor and the second inventor*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27). **Lemble** is silent as to obtaining and assigning a next available docket number to the document. **Takano** in an

analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.*

However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 17, **Lemble** discloses the claimed system of claim 16, wherein said server generated an approval log associated with said disclosure (see column 10, lines 44-52).

As per claim 18, **Lemble** discloses wherein said server associates said approval log with said disclosure (see column 10, lines 4-52 and column 18, line 60 through column 19, line 14).

As per claim 19, **Lemble** discloses the claimed system of claim 16, further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information (see column 25, lines 10-33 and figures 3-4).

5. **Claims 12-15, 33, 37-39, and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemle** in view of AAPA (Applicant's Admitted Prior Art), in view of US Patent 6,434,580 to **Takano**.

As per claim 12, **Lemle** discloses an invention disclosure system comprising: *a user computer, a web server having an identification subsystem*, (see figure 1 and tables in column 7 and column 9); *a database coupled to the server* (see figure 1 and figure 3 and column 4, line 39). **Lemle** further discloses *said server providing user screens to said users so users provide disclosure information to said server*, (see figure 2 and claims 5-6); *receiving disclosure information from said users, storing information in said database* (see column 3, lines 40-62 and column 4, lines 25-47; and claim 1) and (see also column 29, lines 8-15; and figure 4); **Lemle** discloses a screen is provided to a user to enter disclosure information which is stored in the SEALDBA (sealing database) and is prompted to provide a password associated with a disclosure and access to the disclosure is allowed after storing information in the database upon entering the password associated with the disclosure that meets the recitation of *prompting a user to provide a password associated with the disclosure and allowing access to said disclosure after storing said information in said database upon entering the password associated with the disclosure* (see column 4, lines 3-21; column 26, lines 15-37 and column 26, line 64 through column 27, line 34). **Lemle** is silent as to obtaining and assigning a next available docket number to the document. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent

attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure*. However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 13, **Lemble** discloses the claimed system of claim 12, further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information (see column 25, lines 10-33 and figures 3-4).

As per claim 14, **Lemble** discloses the claimed system of claim 12, wherein said server creates a user log (see column (see column 10, lines 44-52).

As per claim 15, **Lemble** discloses the claimed system of claim 12, wherein said server associates said approval log with said disclosure (see column 10, lines 4-52).

As per claim 33, **Lemble** discloses an invention disclosure system comprising: *forming a document online by entering a plurality of selected information including a first user* (user/approver column 14, lines 40-59) *identification information from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 11, 15-16); (as interpreted by Examiner, Lemble discloses in column 6, lines 9-15, column 19, line 50-column 20, line 11 that either the user or the approver can approve the document and the user can be an approver); *storing the selected information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); prompting approval of said first user (user/approver) (see column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); and generating an approval log comprising a date of approval by all inventors and associating the approval log with the document (see column 10, lines 44-52 and column 13, lines 1-8). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document (see column 18, line 60 through column 19, line 14). **Lemble** is silent as to obtaining and assigning a next available docket number to the document. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the

patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.*

However, these features are either implicit, inherent, or obvious in the system disclosed by **Takano** between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10), and requesting a docket number and

obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 37, **Lemble** discloses further comprising the steps of notifying the second user; and, prompting the second user to approve the document (see column 18, lines 1-22; abstract, and figure 4).

As per claim 38, **Lemble** discloses revising the document by the second user to form a revised document, and prompting the first inventor to approve the revised document (see column 20, line 40 through column 21, line 54).

As per claim 39, **Lemble** discloses wherein prompting the second user comprises providing an E-mail to the second user (see column 18, lines 1-22).

As per claim 41, **Lemble** substantially discloses the claimed method of claim 33. **Takano** teaches preparing an online patent application which implicitly or inherently includes assignment document and power of attorney (see **Takano**, column 19, lines 14-53). Therefore, claim 41 is rejected on the same rationale as the rejection of claim 1 above.

6. **Claim 40** is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of AAPA (Applicant's Admitted Prior Art), in view of US Patent 6,434,580 to **Takano** as applied to claims 37-39 and 41 and further in view of US Patent 5,031,214 to **Dziewit et al** (*Applicant's IDS*).

As per claim 40, **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure when the second inventor approves the disclosure (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking of the document. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the document when the second user approves the document*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can

turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention as combined above to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the prior art discloses well-known art of a docketing system assigning docket number.

7.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL COLIN whose telephone number is (571)272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Colin/
Primary Examiner, Art Unit 2436
March 10, 2009